

## **REMARKS/ARGUMENTS**

### **Interview**

The Applicants thank the Examiner for her courtesy and consideration in discussing this Application in a telephone interview on May 31, 2006. Specifically, the Examiner and Applicants discussed independent claims 1 and 14, and the rationale for certain lines of rejection. While no specific areas of agreement were reached, the reasoning behind the rejections was explored. This discussion is reflected in the amended claims submitted herewith, as the amendments are intended to overcome the areas of concern raised by the Examiner.

### **Amendments**

Before this Amendment, claims 1-27 were present for examination. Claims 1, 13, 14, 22, and 23 are amended. Claims 15, 16, 25, and 27 are canceled; and new claim 28 is added. Therefore, claims 1-14, 17-24, 26, and 28 are present for examination, and claims 1, 14, 22, and 28 are the independent claims. No new matter is added by these amendments.

The Office Action rejected claims 1-13, 22-27 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of the article by Caruso entitled "Children's Hospital Shines Light on Net Problems" (hereinafter "Caruso"). The Office Action rejected claims 14, 15, 17-20 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,919,239 to Fraker (hereinafter "Fraker"). The Office Action rejected claim 16 under 35 U.S.C. §103(a) as being unpatentable over Fraker in view of U.S. Patent 5,930,342 to Mazzapica (hereinafter "Mazzapica"). The Office Action rejected claim 21 under 35 U.S.C. §103(a) as being unpatentable over Fraker in view of book by Gralla entitled "How the Internet Works" (hereinafter "Gralla"). The Applicants respectfully request reconsideration of this application as amended.

### **35 U.S.C. §103(a) Rejection, Caruso**

The Office Action rejected claims 1-13, 22-27 under 35 U.S.C. §103(a) as being unpatentable over Caruso. Claims 1 and 22 are the independent claims to which this rejection

applies, and these claims have been amended to recite certain embodiments of the invention more particularly. Claim 22 has also been amended to more closely track claim 1 (albeit with certain distinctions), and thus they are analyzed together.

To establish a *prima facie* case of obviousness, the prior art references must "teach or suggest all the claim limitations." MPEP §2143. Caruso cannot be relied upon to teach the limitation of the claims, as amended. Specifically, Caruso cannot be relied upon to teach or suggest: 1) a business machine comprising a selection from the group consisting of a copier, a printer, a fax machine, a scanner, as recited in claims 1 and 22, 2) threshold events comprising a usage count for the business machine, a level of supplies for the business machine, a detected error in the business machine, or a predetermined time period, as recited in part in claims 1 and 22. Support for the amendments may be found in the Specification (Original Application, p. 3, ll. 10-11, 33-34; p. 7, ll. 17-19).

The Office Action states that the uninterrupted power supply (UPS) of Caruso reads on the business machine of claims 1 and 22 (Office Action, pp. 4, 7). With the amendments specifically limiting a business machine to a copier, a printer, a fax machine, a scanner, or any combination thereof, it is clear that UPS of Caruso is quite different than the business machine of the claims at issue.

The Office Action states that the link utilization monitoring of Caruso reads on the threshold event of claims 1 and 22 (Office Action, pp. 4, 7-8). With the amendments specifically limiting threshold events to usage count for the business machine, a level of supplies for the business machine, a detected error in the business machine, or a predetermined time period, it is clear that link utilization levels of Caruso are different than the threshold events of the claims at issue.

Claims 1 and 22 are further amended to make clear that "the data capture device monitors the business machine to log an occurrence of the threshold event" and that the data capture device transmits a notification triggered by the logging of the threshold event (*See, inter alia*, Original Application, p. 3, ll. 31-33). This differs from Caruso as well, wherein a

centralized "NerveCenter" monitors the power supply at specified threshold levels, and transmits emails when the levels are reached (not a data capture device proximate to the business machine).

**35 U.S.C. §103(a) Rejection, Fraker**

The Office Action rejected claims 14, 15, 17-20 under 35 U.S.C. §103(a) as being unpatentable over Fraker. Claim 14 is the independent claim to which this rejection applies, and this claim has been amended to recite certain embodiments of the invention more particularly. Claim 28 has also been added, and roughly tracks claim 14 (while containing a number of additional limitations, as well), and thus they are analyzed together.

As noted above, for a *prima facie* case of obviousness, the prior art references must teach or suggest all the claim limitations. Fraker cannot be relied upon to teach or suggest 1) a business machine comprising a selection from the group consisting of a copier, a printer, a fax machine, a scanner, as recited in claims 14 and 28, 2) a threshold comprising a usage count for the business machine, a level of supplies for the business machine, a detected error in the business machine, or a predetermined time period, as recited in part in claims 14 and 28. Support for the amendments may be found in the Specification (Original Application, p. 3, ll. 10-11, 33-34; p. 7, ll. 17-19).

The Office Action states that the vehicle of Fraker reads on the business machine of claims 14 and 28 (Office Action, p. 10). With the amendments specifically limiting a business machine to a copier, a printer, a fax machine, a scanner, or any combination thereof, it is clear that the vehicle of Fraker is quite different than the business machine of the claims at issue.

The Office Action states that the vehicle engine temperature monitoring of Caruso reads on the threshold event of claims 14 and 28 (Office Action, pp. 4, 7-8). With the amendments specifically limiting threshold events to usage count for the business machine, a level of supplies for the business machine, a detected error in the business machine, or a

predetermined time period, it is clear that the temperature monitoring of Fraker is different than the threshold events of the claims at issue.

Claims 14 and 28 also recite a "web interface remote to the operations center, wherein the web interface allows users to remotely interact with service contract information and thereby modify the threshold." This remote modification of the threshold is simply not suggested in Fraker.

**Amendments: Conclusion**

Claims 1, 14, 22 and 28 are allowable for at least the foregoing reasons. Claims 2-13, 17-21, 23, 24 and 26 depend from the independent claims, and these claims are believed allowable for at least the same reasons as given above.

**Official Notice**

The Examiner has specifically taken official notice of certain facts in claims 4, 5, 14, 22, and 26. It is respectfully suggested that this issue is moot because the claims are allowable in light of the amendments set forth above. However, out of an abundance of caution, this official notice is traversed.

Official notice is appropriate is only rare cases. MPEP 2144.03 is instructive:

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. ... It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.

If the rejections are maintained, the Applicants hereby request an express showing of documentary proof to support the teaching of these elements as set forth in MPEP 2144.03.

**Drawings**

The Examiner objected to Figures 4, 5A-5E, and 6 pursuant to 37 CFR § 1.84(h)(2) because they are partial views because a) there is no smaller scale view showing the whole, and 2) because the view on the sheets cannot be arranged without concealing part of the whole. The Applicants respectfully request reconsideration of this issue, as 37 CFR § 1.84(h)(2)

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is directed only to a "view of a large machine or device." Figures 4, 5A-5E, and 6, however, are flow diagrams related to a set of processes, and do not constitute "view of a large machine or device," as specified in 37 CFR § 1.84(h)(2). Reconsideration is respectfully requested.


The Examiner objected Figures 4, 5A-5E, and 6 pursuant to 37 CFR § 1.84(u)(1), which requires partial views to have the same Figure number. This objection appears to have merit, and will be addressed accordingly. However, because the resolution of the issues related to 37 CFR § 1.84(h)(2) may impact these changes, the Applicants respectfully suggest that such changes be held abeyance until the 37 CFR § 1.84(h)(2) issues are resolved

### CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

  
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